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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,474	07/07/2000	Paul A. Smethers	UWP1P033/1135	6947
22434	7590	08/25/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			ORGAD, EDAN	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			2684	
DATE MAILED: 08/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/611,474

Applicant(s)

SMETHERS, PAUL A.

Examiner

Edan Orgad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,22-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7,10-19,24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1,3,4, 8,9,20,22,23,26,27,29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3,4, 9, 20, 23, 27,29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Kudoh (US 3 6,008,738).

Regarding claims 1, 20, 27 and 31, Kudoh teaches a method for processing an overloaded key (element 18) on a mobile device (radio pager is a mobile device by definition), said method comprising: receiving a key press of the overloaded key to be processed from a buffer; determining whether the function of the overloaded key has switched; and clearing any subsequent overloaded key presses of the overloaded key from the buffer when said determining determines that the function of the overloaded key has switched (col. 2, lines 58-67 & col. 3, lines 1-23) and setting a pause period for the overloaded key when said determining determines that the function of the overloaded key has switched so that subsequent presses of the overloaded key are ignored during the pause period (col. 3, lines 1-11).

Regarding claims 3, 22 and 29, Kudoh teaches determining whether the overload key press occurred during the pause period; and processing the overloaded key press when said determining determines that the function of the overloaded key has not

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switched and said determining determines that the overloaded key press did not occur during the pause period (col. 3, lines 123).

Regarding claim 4, Kudoh teaches determining whether the function of the overload key has switched comprises determining whether the function of the overloaded key has transitioned from a first function to a second function since its last key press (col. 2, lines 58-67).

Regarding claims 9 and 23, Kudoh teaches the mobile device is a two-way mobile communication device having limited input keys, one of the input keys being the overloaded key (fig. 1 & col. 1, lines 47-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudoh (US 3 6,008,738).

Regarding claims 8, 26 and 30, Kudoh teaches a mobile pager but fails to specifically disclose the mobile device is a personal digital assistant or a cellular phone. However, official notice is taken that it is very well known in the art mobile devices to have a personal digital assistant or a cellular phone that is a pager as well. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was

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made to have Kudoh's mobile pager be a part of a personal digital assistant or a cellular phone in order to further enhance user's needs such as cellular calls, emails etc.

Allowable Subject Matter

Claims 5-7, 10-19, 24 and 25 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claims 5-7, 10-19, 24 and 25, see reasons for allowance in office action # 6, dated 3/12/04.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed 6/14/04 have been fully considered but they are not persuasive.

Regarding applicant's arguments in view of amended claims 1, 20, 27 and 31, applicant has amended the claims above to include the limitations of cancelled claims 2, 21 and 28. Applicant argues that Kudoh (US 6,008,738) fails to disclose setting a pause period for the overloaded key when said determining determines that the function of the overloaded key has switched so that subsequent presses of the overloaded key are ignored

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during the pause period. More specifically, applicant suggests that Kudoh cannot be said to ignore key presses during the pause period. However, it is examiner's contention that Kudoh does disclose ignoring any key presses during the pause period and this is evident in Kudoh col. 51-67 & col. 4, lines 6-16, Kudoh teaches that during the standby state (i.e., pause period) if the overloaded/multi-function is pressed during a timeout period it acts in the same manner it was intended to be used prior to the timeout or pause period. Therefore, if the overloaded/multi-function key is pressed during the pause period, all of its other functions are ignored.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edan Orgad whose telephone number is 703-305-4223. The examiner can normally be reached on 8:00AM to 5:30PM with every other Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 703-305-4223. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Edan Orgad



August 18, 2004

 8/23/04

QUOCHIEN B. VUONG
PRIMARY EXAMINER